

Kenneth C Brooks (SBN 167,792)
Law Offices of Kenneth Brooks
1578 Thunder Ridge Circle
Milpitas, California 95035
Tel: 916 223-9773
Fax: 877 730-4315

Attorney for Plaintiff

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

| | | |
|-------------------------|---|---------------------------------|
| OUTDOOR PRO SHOP, INC., |) | Case No.: |
| Plaintiff, |) | |
| vs. |) | COMPLAINT FOR FEDERAL UNFAIR |
| |) | COMPETITION; FEDERAL |
| OUTDOOR PRO-SHOP LLC, |) | DILUTION; FEDERAL SERVICE MARK |
| |) | INFRINGEMENT COMMON LAW SERVICE |
| Defendant. |) | MARK INFRINGEMENT; CALIFORNIA |
| |) | DILUTION; CALIFORNIA UNFAIR |
| |) | COMPETITION (INJUNCTIVE |
| |) | RELIEF SOUGHT) AND DEMAND FOR |
| |) | JURY |

Plaintiff, OUTDOOR PRO SHOP, INC., a company organized and existing under the laws of the State of California complains against defendants OUTDOOR PRO-SHOP, LLC, a company organized and existing under the laws of the State of Texas, as follows:

JURISDICTION, VENUE AND INTRA-DISTRICT ASSIGNMENT

1. OUTDOOR PRO SHOP, INC.'s first and second claims arise under the Service mark Act of 1946 (the Lanham Act), as amended by the Federal Service mark Dilution Act of 1995 (15 U.S.C. §§ 1051, et seq.) This Court has jurisdiction over such claims pursuant to 28 U.S.C. § 1338(b)(unfair competition), 28 U.S.C. § 1331 (federal question) and 15 U.S.C. § 1121 (Lanham Act). This Court has supplemental jurisdiction over the remaining state law claims

1 under U.S.C. § 1367.

2 2. Venue is proper in this Court under 28 U.S.C. § 1391(b), because OUTDOOR PRO
3 SHOP, INC. transacts affairs in this district and because a substantial part of the events giving
4 rise to the claims asserted arose in this district.

5 3. Intra-district assignment is subject to Local Rules of Court 3-2(c) and thus the case is
6 to be randomly assigned within the district based upon the Assignment Plan, because
7 OUTDOOR PRO SHOP, INC.'s gravamen in the complaint a dispute about its intellectual
8 property and more particularly, unfair competition based upon both Federal and Common Law
9 service mark infringement, despite the actions of OUTDOOR PRO-SHOP LLC giving rise to the
10 causes of action set forth herein occurred in the Counties of Sonoma and San Francisco.

11 **PARTIES**

12 4. Plaintiff, OUTDOOR PRO SHOP, INC., is a company organized and existing under
13 the laws of the State of California and does business both locally and globally advertising and
14 selling products typically used in outdoor sports related activities, such as fishing, boating and
15 the like. OUTDOOR PRO SHOP, INC. has its principle place of business located at 412 Houser
16 St, Cotati, CA 94931 where it has a retail store and does a substantial amount of business over the
17 Internet through a website <http://www.outdoorproshop.com/>.

18 5. OUTDOOR PRO SHOP, INC. is informed and believes that OUTDOOR PRO-SHOP
19 LLC is a limited liability company with a principle place of business at 914 Morley Park Lane,
20 Spring, Texas and is further informed and believes that OUTDOOR PRO-SHOP LLC advertises,
21 distributes and/or sells reels and knives in this judicial district. OUTDOOR PRO SHOP, INC. is
22 further informed and believes that OUTDOOR PRO-SHOP LLC has authorized, directed, and/or
23 actively participated in the wrongful conduct alleged herein.

24 **FACTS AND ALLEGATIONS COMMON TO ALL CLAIMS**

25 **Outdoor Pro Shop, Inc.'s Use of Its Service marks**

1 6. OUTDOOR PRO SHOP, INC. sales its products in connection with its OUTDOOR
2 PRO SHOP service mark in channels of commerce in several countries around the world making
3 the OUTDOOR PRO SHOP service mark well known. For many years prior to the events giving
4 rise to this Complaint and continuing to the present, OUTDOOR PRO SHOP, INC. annually has
5 spent great amounts of time, money, and effort advertising and promoting the services in which
6 products are sold in connection with its service mark and has sold and advertises products in
7 connection with services and advertising all over the world, including throughout the United
8 States and in California. Through this investment and large sales, OUTDOOR PRO SHOP, INC.
9 has created considerable goodwill and a reputation for quality services. OUTDOOR PRO
10 SHOP, INC. continuously has used this service mark to distinguish its services.

11 7. OUTDOOR PRO SHOP, INC. is informed and believes that it is the owner of the
12 OUTDOOR PRO SHOP service mark used in connection with knives and reels and has never
13 consented to OUTDOOR PRO-SHOP LLC's use of OUTDOOR PRO SHOP, INC.'s
14 OUTDOOR PRO SHOP service mark.

15 8. OUTDOOR PRO SHOP, INC. is currently the owner of a the OUTDOOR PRO SHOP
16 service mark that is the subject of United States Service mark Registration number 2,487,671
17 that has been registered on the Principal Register of the United States Service mark Office since
18 September 11, 2001.

19 **Outdoor Pro-Shop Llc's Unlawful Use of Outdoor Pro Shop, Inc.'s Mark**

20 9. OUTDOOR PRO SHOP, INC. is informed and believes that OUTDOOR PRO-SHOP,
21 LLC currently provides retail stores services and advertising services for goods used in
22 connection with the service mark OUTDOOR PRO-SHOP through the same channels of trade
23 and offered and sold to the same class of purchasers as the retail store services and advertising
24 services as provided by OUTDOOR PRO SHOP, INC. using the service mark OUTDOOR PRO
25 SHOP.

10. Upon information and belief, OUTDOOR PRO SHOP, INC. 's use of its OUTDOOR PRO SHOP service mark in the United States pre-dates both OUTDOOR PRO-SHOP, LLC 's first use of its OUTDOOR PRO-SHOP mark.

11. Upon information and belief, OUTDOOR PRO-SHOP, LLC's use of the phrase OUTDOOR PRO-SHOP will cause a likelihood of confusion as to the source and quality of services provided by services with services provided by OUTDOOR PRO SHOP, INC. under its OUTDOOR PRO SHOP service mark.

FIRST CLAIM
FEDERAL UNFAIR COMPETITION
(False Designation of Origin and False Description)
(15 U.S.C. § 1125(a); Lanham Act § 43(a))

12. OUTDOOR PRO SHOP, INC. realleges and incorporates by reference each of the allegations contained in paragraphs 1 through 11 of this Complaint.

13. OUTDOOR PRO-SHOP, LLC 's conduct constitutes the use of symbols or devices tending falsely to describe the infringing services, within the meaning of 15 U.S.C. § 1125(a)(1). OUTDOOR PRO-SHOP, LLC 's conduct is likely to cause confusion, mistake, or deception by or in the public as to the affiliation, connection, association, origin, sponsorship or approval of the infringing services to the detriment of OUTDOOR PRO SHOP, INC. and in violation of 15 U.S.C. § 1125(a)(1).

14. As a direct and proximate result of OUTDOOR PRO-SHOP, LLC 's infringing activities, OUTDOOR PRO SHOP, INC. has suffered substantial damage.

SECOND CLAIM
FEDERAL DILUTION OF A FAMOUS MARK
(Federal Service mark Dilution Act of 1995)
(15 U.S.C. § 1125(c); Lanham Act § 43(c))

15. OUTDOOR PRO SHOP, INC. realleges and incorporates by reference each of the allegations contained in paragraphs 1 through 14 of this Complaint.

1 16. OUTDOOR PRO SHOP, INC. 's OUTDOOR PRO SHOP service mark is distinctive
2 and famous within the meaning of the Federal Service mark Dilution Act of 1995, 15 U.S.C. §
3 1125(c), as amended.

4 17. OUTDOOR PRO-SHOP, LLC 's activities as alleged herein have been diluted or are
5 likely to dilute the distinctive quality of OUTDOOR PRO SHOP, INC. 's service mark in
6 violation of the Federal Service mark Dilution Act of 1995, 15 U.S.C. § 1125(c).

7 18. OUTDOOR PRO SHOP, INC. is entitled to injunctive relief pursuant to 15 U.S.C. §
8 1125(c), because OUTDOOR PRO-SHOP, LLC willfully intended to trade on OUTDOOR PRO
9 SHOP, INC. 's reputation or to cause dilution of OUTDOOR PRO SHOP, INC. 's famous
10 OUTDOOR PRO SHOP service mark is entitled to damages, extraordinary damages, fees and
11 costs pursuant to 15 U.S.C. § 1125(c)(2).

12 **THIRD CLAIM**
13 **COMMON LAW SERVICE MARK INFRINGEMENT**

14 19. OUTDOOR PRO SHOP, INC. realleges and incorporates by reference each of the
15 allegations contained in paragraphs 1 through 18 of this Complaint.

16 20. OUTDOOR PRO SHOP, INC. is informed and believes that it has used its
17 OUTDOOR PRO SHOP service mark in retail store sales and advertising services in connection
18 with knives and reels, as well as other outdoor sporting equipment in the state of California
19 before OUTDOOR PRO-SHOP, LLC 's use of the OUTDOOR PR-SHOP service mark and that
20 OUTDOOR PRO SHOP, INC. 's use of its OUTDOOR PRO SHOP service mark has been
21 continuous in the state of California since its first use thereof.

22 21. OUTDOOR PRO SHOP, INC. is informed and believes that OUTDOOR PRO-
23 SHOP, LLC 's use of the OUTDOOR PRO-SHOP service mark are in the same channels of
24 commerce in which OUTDOOR PRO SHOP, INC. uses its OUTDOOR PRO SHOP service
25 mark and that OUTDOOR PRO-SHOP, LLC directs its use of the OUTDOOR PRO-SHOP

1 service mark to the same class of purchasers in which OUTDOOR PRO SHOP, INC. directs the
2 use of its OUTDOOR PRO SHOP service mark.

3 **FOURTH CLAIM**
4 **CALIFORNIA DILUTION**
(Cal. Bus. & Prof. Code § 14247, 14250)

5 22. OUTDOOR PRO SHOP, INC. realleges and incorporates by reference each of the
6 allegations contained in paragraphs 1 through 21 of the Complaint.

7 23. OUTDOOR PRO SHOP, INC. has made commercial use of its OUTDOOR PRO
8 SHOP service mark.

9 24. Upon information and belief OUTDOOR PRO-SHOP, LLC 's use of the
10 OUTDOOR PRO-SHOP began after OUTDOOR PRO SHOP, INC. 's OUTDOOR PRO SHOP
11 service mark became famous.

12 25. Upon information and belief OUTDOOR PRO-SHOP, LLC 's infringed and diluted
13 OUTDOOR PRO SHOP, INC. 's OUTDOOR PRO SHOP service mark with knowledge and
14 intent to cause confusion, mistake or deception and has diluted OUTDOOR PRO SHOP, INC. 's
15 OUTDOOR PRO SHOP service mark as a result.

16 26. OUTDOOR PRO-SHOP, LLC 's conduct is aggravated by that kind of willfulness,
17 wantonness, malice and conscious indifference to the rights and welfare of OUTDOOR PRO
18 SHOP, INC. 's for which California law allows the imposition of exemplary damages.

19 27. Pursuant to California Business & Professions Code §§ 14247 and 14250,
20 OUTDOOR PRO SHOP, INC. is entitled to injunctive relief and damages in the amount of three
21 times OUTDOOR PRO-SHOP, LLC 's profits and three times all damages suffered by
22 OUTDOOR PRO SHOP, INC. by reason of OUTDOOR PRO-SHOP, LLC 's use, display or sale
23 of infringing services.

24 **FIFTH CLAIM**
CALIFORNIA UNFAIR COMPETITION
25 (Cal. Bus. & Prof. Code § 17200)

28. OUTDOOR PRO SHOP, INC. realleges and incorporates by reference each of the allegations contained in paragraphs 1 through 27 of this Complaint.

29. OUTDOOR PRO-SHOP, LLC 's infringement of OUTDOOR PRO SHOP, INC. 's OUTDOOR PRO SHOP service mark constitutes unfair business acts or practices within the meaning of California Business & Professions Code § 17200.

30. As a consequence of OUTDOOR PRO-SHOP, LLC 's actions, OUTDOOR PRO SHOP, INC. is entitled to injunctive relief and an order that OUTDOOR PRO-SHOP, LLC disgorge all profits on the manufacture, use, display or sale of infringing services.

PRAYER FOR JUDGMENT

WHEREFORE, OUTDOOR PRO SHOP, INC. prays that this Court grant it the following relief:

31. Adjudge that OUTDOOR PRO SHOP, INC. 's OUTDOOR PRO SHOP service mark has been infringed by OUTDOOR PRO-SHOP, LLC in violation of OUTDOOR PRO SHOP, INC. 's rights under common law, and/or California law;

32. Adjudge that OUTDOOR PRO-SHOP, LLC has competed unfairly with OUTDOOR PRO SHOP, INC. in violation of OUTDOOR PRO SHOP, INC. 's rights under common law, 15 U.S.C. § 1125(a), and/or California law;

33. Adjudge that OUTDOOR PRO-SHOP, LLC 's activities are likely to, or have, diluted OUTDOOR PRO SHOP, INC. 's famous OUTDOOR PRO SHOP service mark in violation of OUTDOOR PRO SHOP, INC. 's rights under common law, 15 U.S.C. § 1125(c), and/or California law;

34. Adjudge that OUTDOOR PRO-SHOP, LLC and each of his agents, employees, attorneys, successors, assigns, affiliates, and joint venturers and any person(s) in active concert or participation with any of them, and/or any person(s) acting for, with, by, through or under any of them, be enjoined and restrained at first during the pendency of this action and thereafter permanently from:

1 a. Manufacturing, producing, sourcing, importing, selling, offering for sale, distributing,
2 advertising, or promoting any services or goods that display any words or symbols that so
3 resemble OUTDOOR PRO SHOP, INC. 's OUTDOOR PRO SHOP service mark as to likely
4 cause confusion, mistake or deception, on or in connection with any product that is not
5 authorized by or for OUTDOOR PRO SHOP, INC., including without limitation any service or
6 product that bears the OUTDOOR PRO-SHOP, LLC 's designs or any other similar
7 approximation of OUTDOOR PRO SHOP, INC. 's OUTDOOR PRO SHOP service mark;

8 b. Using any word, term, name, symbol, device or combination thereof that causes or is
9 likely to cause confusion, mistake or deception as to the affiliation or association of OUTDOOR
10 PRO-SHOP, LLC or his goods with OUTDOOR PRO SHOP, INC. or as to the origin of
11 OUTDOOR PRO-SHOP, LLC 's goods, or any false designation of origin, false or misleading
12 description or representation of fact;

13 c. Further infringing the rights of OUTDOOR PRO SHOP, INC. in and to any of its
14 service marks in its brand products or otherwise damaging OUTDOOR PRO SHOP, INC.'s
15 goodwill or business reputation;

16 d. Otherwise competing unfairly with OUTDOOR PRO SHOP, INC. in any manner; and

17 e. Continuing to perform in any manner whatsoever any of the other acts complained of
18 in this Complaint;

19 35. Adjudge that OUTDOOR PRO-SHOP, LLC be required immediately to supply
20 OUTDOOR PRO SHOP, INC. 's counsel with a complete list of individuals and entities from
21 whom or which he purchased, and to whom or which he sold, offered for sale, distributed,
22 advertised or promoted, infringing products as alleged in this Complaint;

23 36. Adjudge that OUTDOOR PRO-SHOP, LLC be required immediately to deliver to
24 OUTDOOR PRO SHOP, INC.'s counsel its entire inventory of infringing products, packaging,
25 labeling, advertising and promotional material and all plates, patterns, OUTDOOR PRO-SHOP,

1 LLC and other material for producing or printing such items, that is in OUTDOOR PRO-SHOP,
2 LLC 's possession or subject to his control and that infringes OUTDOOR PRO SHOP, INC. 's
3 OUTDOOR PRO SHOP service mark;

4 37. Adjudge that OUTDOOR PRO-SHOP, LLC, within thirty (30) days after service of
5 the judgment demanded herein, be required to file with this Court and serve upon OUTDOOR
6 PRO SHOP, INC. 's counsel a written report under oath setting forth in detail the manner in
7 which he has complied with the judgment;

8 38. Adjudge that OUTDOOR PRO SHOP, INC. recover from OUTDOOR PRO-SHOP,
9 LLC its damages and lost profits in an amount to be proven at trial;

10 39. Order an accounting of and impose a constructive trust on all of OUTDOOR PRO-
11 SHOP, LLC 's funds and assets that arise out of OUTDOOR PRO-SHOP, LLC 's infringing
12 activities;

13 40. Adjudge that OUTDOOR PRO SHOP, INC. be awarded its costs and disbursements
14 incurred in connection with this action, including OUTDOOR PRO SHOP, INC. 's reasonable
15 attorneys' fees and investigative expenses; and

16 41. Adjudge that all such other relief be awarded to OUTDOOR PRO SHOP, INC. as
17 this Court deems just and proper.

18 DEMAND FOR JURY TRIAL

19 Pursuant to Rule 38 of the Federal Rules of Civil Procedure, the OUTDOOR PRO SHOP,
20 INC. demands trial by jury in this action of all issues so triable.

21 Dated: January 21, 2016

22 /s/Kenneth C. Brooks

23 LAW OFFICE OF KENNETH C. BROOKS
24 KENNETH C. BROOKS
25 Attorney for Plaintiff